

REMARKS

Claims 21-34 and 36-42 remain in this application. Claim 35 is canceled.

Page 3 of the Official Action objects to drawing Figures 1-2 as not being labeled.

This objection is not understood. Each of Figures 1-2 are labeled as such, the figure label being located at the lower right corner below the figure itself. Further, element reference numbers are located within each figure.

In view of this, each of the drawing figures is believed to be satisfactory and no amendment is needed. Withdrawal of the drawing objection is requested. If there is some other defect, it is requested that such defect be more specifically identified.

The abstract was object to (page 4) for not appearing on a separate sheet, apart from any other text.

A replacement abstract, on a separate sheet, is provided. Withdrawal of the abstract objection is solicited.

The specification was objected to with respect to the recitations of claims 26-27 not being found, i.e., that the phrase "which location information is within the knowledge of the network". This phrase was within the originally filed specification. See original claims 6-7, reproduced below:

6. A method according to claim 1, wherein the location service utilizes the location information on the mobile terminal,

which location information is within the knowledge of the network.

7. A method according to claim 4, wherein the mobile terminal utilizes the location information on the mobile terminal, which location information is within the knowledge of the network.

The paragraph spanning pages 2-3 has been amended to incorporate this passage. Withdrawal of the objection is solicited.

The Official Action objected to claims 22-42 (page 4).

The claims have been amended responsive to the claim objections, except the term "means" is believed to be better than "means for" once the means has been initially recited. Withdrawal of the claim objections is solicited.

The Official Action rejected claims 26, 27, 33, 37, and 41 (page 5) under section 35 USC 112, second paragraph as being indefinite. Each basis for rejection was insufficient antecedent basis for a limitation.

The claims have been amended to remedy the stated basis of rejection. Withdrawal of the rejection is solicited.

No new matter has been introduced by way of these amendments.

Rejections under 35 USC 103

Claims 21-42 were rejected as obvious over TEARE 5,243,652 in view of GIROUX 2002/0078361 and PIRILA 6,674,860.

Applicant respectfully disagrees.

The following features of claims 21, and the corresponding features of claims 33 and 42, are neither taught nor suggested:

- a data connected to a certain area being encrypted;

and

- a mobile terminal adapted for use by decrypting the data/information.

Further, the applied art does not teach or suggest the following feature of claim 21, and the corresponding features of claims 33, 41, and 42:

- location information on the mobile terminal transported from the location service in the communication network to the server.

As each independent claim is non-obvious, the dependent claims are non-obvious.

TEARE

With respect to method claim 21, TEARE discloses that the programming information may be video or data programming material which can be viewed via a user interface after it has been decrypted. TEARE also teaches that the server receives

location information from user equipment, the location information being position history.

TEARE does not teach a data connected to a certain area being encrypted, a mobile terminal adapted for use by decrypting the data/information, or location information on the mobile terminal transported from the location service in the communication network to the server.

GIROUX

GIROUX discloses that the decrypted information is viewed by a user, and that the electronic information may be video, audio, pictorial, or electronic data. Further, GIROUX teaches that geographical positioning data can be provided by a GPS or LORAN device used with the viewing tool (user equipment). Thus, GIROUX teaches to find out the location information from a mobile station which is contrary to the claimed feature in which the server finds out location information on the mobile station from a location service in a network.

Thus, GIROUX also does not teach a data connected to a certain area being encrypted, a mobile terminal adapted for use by decrypting the data/information, or location information on the mobile terminal transported from the location service in the communication network to the server.

Further, as GIROUX teaches to find out the location information from a mobile station which is contrary to the claimed feature in which the server finds out location

information on the mobile station from a location service in a network, it is improper to combine this reference with TEARE. The Federal circuit has held that it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Also, "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). In an obviousness rejection, it is impermissible "to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965).

#### PIRILA

PIRILA discloses that the encrypted information is the transmitted location information itself.

Accordingly, PIRILA also does not teach a data connected to a certain area being encrypted, a mobile terminal adapted for use by decrypting the data/information, or location information on the mobile terminal transported from the location service in the communication network to the server.

Summary

The proposed combination of references fails to teach the recited invention.

It is not sufficient that the references are somehow related to the same technology or field of use. The Federal Circuit emphasized in July, 1998 that “[m]ost, if not all, inventions are combinations and mostly of old elements.” *In re Rouffett*, 47 USPQ 2d 1453, 1457 citing to *Richdel, Inc. v. Sunspool Corp.*, 219 USPQ 8, 12 (Fed. Cir. 1983). The Federal Circuit continued by noting that “rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blue print for piecing together elements in the prior art to defeat the patentability of the claimed invention.”

Thus, the Federal Circuit requires that in order to prevent the use of such hindsight, the Official Action must “show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” (*In re Rouffett* at 1458). The present rejection fails to meet this requirement.

The Federal Circuit has also held that in determining the differences between the prior art and the claims, the question under 35 USC 103 is not whether the differences

themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). The Federal Circuit has held that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

This approach is consistent with KSR.

The Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If that burden is met, then the burden shifts to the Appellants to overcome the *prima facie* case with argument and/or evidence. (See *Id.*) The Examiner has not satisfied this burden.

In performing this obviousness analysis, the Examiner is required to make findings of fact and must provide an articulated reasoning supporting the rejection. The Examiner's articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

The Supreme Court citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) stated that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there

must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

The present rejection hasn't made sufficient proper findings of fact to support the rejection and rather relies on conclusory statements.

The recited invention, when considered as a whole, is believed to be non-obvious. Reconsideration and allowance of all the claims are respectfully requested.

This response is believed to be fully responsive and to put the case in condition for allowance. An early and favorable action on the merits is earnestly requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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REL/jr



**APPENDIX:**

The Appendix includes the following item(s):

a new Abstract of the Disclosure